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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,728	10/06/1999	THOMAS J. MARSAN	B-65583(0143	2353

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CHRISTOPHER J. ROURK
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
P O BOX 688
DALLAS, TX 75313-0688

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/413,728

Applicant(s)

MARSAN ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 3,11-15 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claim 11**, it is not clear what aspect of a retrieval request code causes the prohibition to occur.

As per **claim 12**, it is not clear what aspect of issuing bank data causes the prohibition to occur.

As per **claim 13**, it is not clear what aspect of bankcard agency data causes the prohibition to occur.

As per **claim 14**, it is not clear what aspect of transaction amount data causes the prohibition to occur.

As per **claim 15**, it is not clear what aspect of card user data causes the prohibition to occur.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3629

Claims rejected under 35 U.S.C. 102(b) as being anticipated by Nair et al. (U. S. 5,479,530).

Nair et al. teach to an apparatus and method for capturing a signature applied to a receipt, comprising:

As per **claims 1, 8 and 9, 10**:

- a substitute draft system operable to receive a retrieval request and to generate a substitute draft in response (a transaction processor receives a retrieval request and reproduces the receipt) (Fig. 33; column 68, lines 9-28);

- a merchant system operable to generate a merchant request in response to the retrieval request (transaction processors respond to the retrieval requests on behalf merchants) (column 67, lines 62-63);

As per **claim 2**, the term "inhibit system" encompasses transaction processor (See Fig. 2, item 12);

As per **claims 4 and 5**,

- merchant system operable to receive the merchant request and retrieve identification data in response (the host computer 40 of the transaction processor causes a receipt file stored in the storage to be searched) (column 68, lines 14-16);

As per **claims 6 and 7**,

- bankcard system and bank system operable to generate the retrieval request and receive the substitute draft (bank card association generate a retrieval request and receive reproduced receipt) (column 18, lines 30-31; column 68, lines 9-28, 36-39). The bankcard association comprises banks that issue credit cards (column 17, lines 20-27).

As per **claims 16-17**,

- a bank system operable to generate the retrieval request in response to user-entered data (bank generate a retrieval request) (column 18, lines 30-31; column 68, lines 9-28);

- a bankcard system comprising banks operable to receive the retrieval request from the banks (column 17, lines 20-27; column 18, lines 30-31; column 68, lines 9-28);

- a transaction system coupled to the bankcard system operable to receive the retrieval request and to generate a substitute draft and a merchant request (column 18, lines 30-31; column 67, lines 62-63; column 68, lines 9-28);

- a merchant system coupled to the merchant interface and operable to receive the merchant request and generate sales draft data in response (column 67, lines 62-63).

As per **claims 17-19**, the transaction system (processor) is operable to receive bank system data, card user data and transaction amount data with the retrieval request and to generate a substitute draft in response (column 67, lines 62-67; column 68, lines 4-6, 11-14).

Claims 3 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Art Unit: 3629

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Price et al. 5,561,282

Rouse 5,860,066

Camp et al. 6,317,729

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100